

REMARKSPending Claims

Claims 1-3, 6-13, 17-18, 20, 23, and 28-29 are currently pending as the claims for which Applicants have paid. Claims 4, 5, 19, 21, 22, 24-27, and 30-45 were intended to be cancelled as stated in Item 3 of the Continuation Application Transmittal Letter. Applicants submit that these claims were included in the application as filed in the interest of providing notice to the public of certain specific subject matter intended to be claimed, and were intended to be cancelled at the time of filing this application in the interest of reducing filing costs. Applicants expressly state that these claims are not being cancelled for reasons related to patentability, and are in fact fully supported by the specification as filed. Applicants expressly reserve the right to reinstate these claims, or to add other claims during prosecution of this application, or a continuation or divisional application. Applicants expressly do not disclaim the subject matter of any invention disclosed herein which is not set forth in the instantly filed claims.

Restriction Requirement

Applicants note that claims 4, 5, 19, 21, 22, 24-27, and 30-45 were cancelled in the transmittal, therefore groups VI, VIII, IX, XI, XII, XIII, XIV, XVII, XVIII, XIX, and XX refer to cancelled claims. The claims that are still pending have been restricted as follows:

- Group I. Claims 1-2, 17-18, drawn to an isolated polypeptide.
- Group II. Claims 3, 6-8, 12-13, drawn to an isolated polynucleotide, vectors, transformed cells, a transgenic animal.
- Group III. Claims 9-10, drawn to a method of producing a polypeptide.
- Group IV. Claim 11, drawn to an isolated antibody.
- Group V. Claims 14-16, drawn to a method of detecting a target polynucleotide.
- Group VII. Claim 20, drawn to a method of screening a compound for effectiveness as an agonist.
- Group X. Claim 23, drawn to a method of screening a compound for effectiveness as an antagonist.
- Group XV. Claims 28, drawn to a method of screening a compound for its ability to alter expression of a target polynucleotide.

Group XVI. Claim 29, drawn to a method of assessing toxicity of a test compound comprising the use of a polynucleotide.

Applicants hereby elect, with traverse, to prosecute Group I, which includes and is drawn to Claims 1-2, and 17-18. Applicants reserve the right to prosecute the subject matter of non-elected claims in subsequent divisional applications.

Applicants also submit that the invention encompassed by Groups XII and X (claims 20 and 23) are drawn to methods of use of the polypeptide of Group I, and should be examined together. These method claims recite a product (i.e., a polypeptide), which is of the same scope as the claimed polypeptide being searched by the Examiner. Therefore, it would not be an undue burden on the Examiner to examine these method claims since the searches for the claimed polypeptide and these method claims would substantially overlap.

Applicants also suggest that Group IV, drawn to antibodies to the polypeptide, be examined at the same time, also without undue burden on the Examiner. Applicants traverse the Restriction Requirement between Group I and Group IV, drawn to the polypeptide and antibodies to the polypeptide, respectively. A search of the prior art to determine the novelty of the antibodies would substantially overlap with a search of the claims directed to the polypeptide. Therefore, applicants submit that examining the prior art for the polypeptide together with the antibodies would involve substantially the same subject matter and would not impose undue burden on the Examiner.

Applicants also respectfully submit that there is minimal additional burden on the Examiner to examine claims IV, XV, and XVI in addition to the claims elected in the present application, particularly in view of the searches and examination which were already conducted with respect to the previously issued claims and the additional burden on Applicants to file, prosecute and maintain yet another application in this family, and respectfully request that the Examiner consider doing so.

Applicants note in addition that claims directed to the polynucleotide of Group II (claims 3, 6-8, and 12-13), although of somewhat different scope, have already been examined and allowed in the parent application. Groups XV and XVI (claims 28-29) are directed to a method of use of the polynucleotide of Group II, and could be examined together, without undue burden on the Examiner.

Additionally, the method claims of Groups III, VII, and X are entitled to rejoinder upon allowance of a product claim per the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)" which sets forth the rules, upon allowance of a product claim, for rejoinder of process claims covering the same scope of products. See also M.P.E.P. 821.04 as follows.

Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. . . . The claims to the nonelected invention will be withdrawn from further consideration under 37 C.F.R. 1.142. . . . However, if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Thus, Applicants request reconsideration and withdrawal of the Restriction Requirement and examination of the entirety of Applicants' claims.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

Respectfully submitted,  
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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

**The following paragraph has been added after the title:**

This application is a continuation application of U.S. application serial number 09/095,351, filed June 9, 1998, which is a divisional of 08/781,562, filed January 9, 1997, now U.S. Patent Number 5,763,589, issued June 9, 1998.